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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/984,979 12/04/97 BAER

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EXAMINER

MM91/0412

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NGUYEN, T
ART UNIT

PAPER NUMBER

2877
DATE MAILED:

04/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/984,979

Applicant(s)
Baer et al.

Examiner
Tu T. Nguyen

Group Art Unit
2877



☒ Responsive to communication(s) filed on Jan 4, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-77 is/are pending in the application.

Of the above, claim(s) 45-48 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-44 and 49-77 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---



UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231

Paper No. 17

Serial Number: 08/984,979

Filing Date: 12/04/97

Detailed Office Action

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 49-50,52,63-64,70,77 are rejected under 35 U.S.C. 102(a) as being anticipated by Science article, vol 278.

Science, vol 278, discloses a Laser Capture Microdissection (LCM hereinafter) system comprising: a transfer film carrier (fig 1, transport arm or column 3, last line), a LCM film coupled to the carrier (fig 1, transfer film on backing), a cap (fig 1, plastic cap) a plate (just below the cap).

With respect to claim 50, the expanded transfer film would have been inherent because the transfer film need expands and projects itself away from the substrate in order to pick only a wanted tissue.

With respect to claim 52,70, the transfer film in Vol 278 contains an absorptive substance (column 3, second paragraph or column 2, last paragraph).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-44,51,53-62,65-69,71-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Article Science, Vol 278 in view of Chao et al (5,633,535) or Seffernick (5,621,619) or Nagahara et al (3,995,941).

Science, vol 278, discloses a Laser Capture Microdissection (LCM hereinafter) system comprising: a transfer film carrier (fig 1, transport arm or column 3, last line), a LCM film coupled to the carrier (fig 1, transfer film on backing), a cap (fig 1, plastic cap) a plate (just below the cap).

With respect to claims 1,15-16,30-31,44, Vol 278 discloses the claimed invention except for the spacer or standoff to control the space. Chao (fig 1, 15 or fig 5, 42, column 2, lines 50+) or Seffernick (fig 1, 5 or column 4, lines 20-30) or Nagahara (column 4, lines 10-25) discloses

a spacer or a standoff for controlling the space between two surfaces; specially Nagahara discloses an integrally formed spacer (column 4, lines 10-25). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine Vol 278 with the spacer in the prior arts for controlling the space between two surfaces to save the cost as taught by Chao in column 2, lines 50-60.

With respect to claims 2,17, the expanded transfer film would have been inherent because the transfer film need expands and projects itself away from the substrate in order to pick only a wanted tissue.

With respect to claims 3,5-9,18,20-24,38-39,43,51,53-57,71-76, The claimed limitations would have been a design choice, since the general conditions of the invention are described by the prior art, modifying the prior art with a scattering media or hot vacuum bake or transparent glue or a negative draft or diffuser involve only routine skill in the art.

With respect to claims 4,19,37, the transfer film in Vol 278 contains an absorptive substance (column 3, second paragraph).

With respect to claims 10-12,25-27,40-42,58-60, Vol 278 discloses the claimed invention except for the transfer film thickness or length of the spacer. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the prior art system with different film thickness or different spacer length, since it would have been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

With respect to claims 13,28,61, a pedestal that protrudes and defines an acquisition zone is well known in the art, i.e. a cookie cutter. It would have been obvious to one having ordinary

skill in the art at the time of the invention was made to modify the claimed pedestal with a transfer film to make the system more accurate.

With respect to claims 14,29,62, the claimed pedestal that runs at least three points of a perimeter would have been a design choice. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the shape or area of the pedestal to meet a design choice.

With respect to claims 32-34,65-67, Vol 278 discloses the claimed invention except for the release layer. A release layer consisting of silicones and polytetrafluoroethylenes is well known in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the system in vol 278 with a release layer to make the system easier to clean or easier to handle the tissue.

With respect to claim 35,68, Vol 278 discloses a conical vial cap which performs the same function as the claimed Plano-concave void.

With respect to claim 36,69 the claimed transparent thermoplastic would have been inherent for the LCM. It is disclosed in the article XP000644727, column 2, last paragraph.

Papers related to this application may be submitted to TC 2877 by facsimile transmission. Papers should be faxed to TC 2877 via the PTO Fax Center located in CP4-4C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Center number is (703)308-7722.

If the Applicant wishes to send a Fax dealing with either a Proposed Amendment or for discussion for a phone interview then the fax should:

a) Contain either the statement "DRAFT" or "PROPOSED AMENDMENT" on the Fax Cover Sheet; and


b) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Tuan Nguyen whose telephone number is (703) 306-9185.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Tu Tuan Nguyen
Patent Examiner
TC 2877
April 05, 2001/TTN


Frank G. Font
Supervisory Primary Examiner
Group Art Unit 2877